



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#10
m.m.
1/16/03

In re application of

Docket No: Q62550

Takuya SEKO, et al.

Confirmation No.: 2333

Appln. No.: 09/743,393

Group Art Unit: 1625

Filed: January 10, 2001

Examiner: Huang, E.

For: AMINO ACID DERIVATIVES AND PHARMACEUTICAL COMPOSITION
COMPRISING, AS ACTIVE INGREDIENTS, THEM

REQUEST FOR REFUND

Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicants hereby respectfully requests a refund in the amount of **\$920.00**. This refund is to be credited to Deposit Account No. 19-4880.

Specifically, Applicants filed a Response to Restriction Requirement on April 24, 2002 (as evidenced by the copy of Response and date-stamped mailroom receipt attached hereto), in reply to the Office Action dated January 24, 2002 (a copy of which is also attached), wherein it is noted that the response time is set as three (3) months from the date of the Action. Therefore, Applicants submit that the Response to the Office Action was timely filed, and the \$920.00 three month extension of time fee (see the Deposit Account Monthly Statement dated April 30, 2002, attached hereto) was erroneously charged.

Adjustment date: 01/16/2003 MAY22
04/29/2002 GANTHONY 00000002 194880 09743393
01 FC:117 92010068

Hence, Applicants request the refund of **\$920.00** be made to the Deposit Account as indicated above. A duplicate copy of this paper is attached.

Respectfully submitted,

Drew Hissong
Registration No. 44,765

SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037-3213
Telephone: (202) 293-7060
Facsimile: (202) 293-7860
Date: December 19, 2002



72

FILING RECEIPT
PLEASE DATE STAMP AND RETURN TO US - BOX 235X

In re application of

Takuya SEKO, et al.

Appln. No. 09/743,393

Group Art Unit: 1614

Confirmation No.: 2333

Examiner: Not yet assigned

Filed: January 10, 2001

For: AMINO ACID DERIVATIVES AND PHARMACEUTICAL COMPOSITION
COMPRISING, AS ACTIVE INGREDIENTS, THEM

PAPER(S) FILED ENTITLED:

1. Response Under 37 C.F.R. §1.111

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DOCKET NO.: Q62550
ATTORNEY/SEC: JMH/ddw

Date Filed: April 24, 2002





PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Takuya SEKO, et al.

Appln. No.: 09/743,393

Group Art Unit: 1614

Confirmation No.: 2333

Examiner: Not yet assigned

Filed: January 10, 2001

For: AMINO ACID DERIVATIVES AND PHARMACEUTICAL COMPOSITION
□COMPRISING, AS ACTIVE INGREDIENTS, THEM

**RESPONSE TO RESTRICTION/ELECTION REQUIREMENT
UNDER 37 C.F.R. § 1.111**

APR 24 2002

Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action dated January 24, 2002¹, Applicants elect, with traverse, Group I, claims 1-5, 8-10 and 12-15 in part, drawn to a compound wherein R¹ is thiazolidinyl, R³ is a carbocyclic ring and R⁴ is a heterocyclic ring, the composition and method of use. Further Applicants select (2R)-N-(1-benzylpiperidin-4-yl)-3-cyclohexylmethylthio-2-((4R)-3-(3,3-dimethylbutyryl) thiazolidin-4-ylcarbonylamino)propanamide disclosed in Example 11(2) as the elected species.

Applicants respectfully traverse the restriction/election requirement and submit that it is unclear whether the elected species falls within Group I or Group III. As shown on the attached

¹ Applicants note that a three month response period was set in the Office Action dated January 24, 2002, therefore the response is timely filed on April 24, 2002.

Response to Restriction/Election Requirement
U.S. Appln. No. 09/743,393

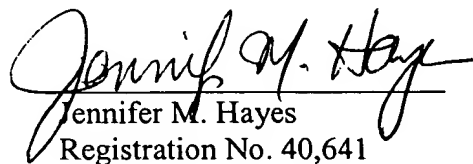
sheet, it is not clear whether R³ of the compound of the elected species is considered as a carbocyclic ring within the scope of Group I, or a C₁₋₄ alkyl substituted with a carbocyclic ring within the scope of Group III. Further Applicants submit that R¹ of the claimed invention should be classified as a heterocyclic ring as recited in the claims instead of as a thiazolidinyl as recited by the Examiner.

Applicants thank the Examiner for discussing this matter during a telephone conversation on April 23, 2002, in which the Examiner indicated that the restriction requirement would be reconsidered upon election of a species.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. 19-4880.

Respectfully submitted,


Jennifer M. Hayes
Registration No. 40,641

SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, N.W.
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Date: April 24, 2002



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/743,393	01/10/2001	Takuya Seko	Q62550	2333

7590

01/24/2002

Sughrue Mion Zinn Macpeak & Seas
2100 Pennsylvania Avenue NW
Washington, DC 20037

EXAMINER

HUANG, EVELYN MEI

ART UNIT

PAPER NUMBER

1625

DATE MAILED: 01/24/2002

DOCKETED

JAN 28 2002

Please find below and/or attached an Office communication concerning this application or proceeding.



Office Action Summary

Application No.

09/743,393

Applicant(s)

SEKO ET AL.

Examiner

Evelyn Huang

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-15 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 11, and claims 1-5, 8-10, 12-15 in part, drawn to a compound wherein R1 is thiazolidinyl, R3 is a carbocyclic ring, and R4 is a heterocyclic ring, the composition and method of use thereof. If this group is elected, an election of a species within this group is also required.

Group II, claim(s) 1-5, 8-10, 12-15 in part, drawn to a compound wherein R1 is thiazolidinyl, R3 is a carbocyclic ring, and R4 is a carbocyclic ring, the composition and method of use thereof. If this group is elected, an election of a species within this group is also required.

Group III, claim(s) 6, 7 and claims 1-5, 8-9, 12-15 in part, drawn to a compound not described in group I or group II, the composition and method of use thereof. If this group is elected, an election of a species within this group is also required and further restriction would be required based on the elected species.

The inventions listed as Groups I, II, III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Unity of invention exists where compounds included within a Markush group share a common utility *and* share a *substantial* structural feature disclosed as being essential to that utility. The only common core is -N-CH-C(O)-, which is *not* a *substantial* structural feature.

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The Markush elements in the instant claims are so diverse in scope that a common nucleus essential to that utility is lacking. For example, while these compounds are inhibitors of an N-type calcium channel, a compound within the genus of claim 1 is known to be antagonists of tachykinin (Esser, 5596000, PTO-1449).

A reference anticipates compounds being drawn to group I invention does not render obvious the compounds of group II or III invention. The search is not co-extensive and is burdensome. Since the search required for group I invention is not required for the other groups, the restriction requirement as indicated is therefore proper.

2. A telephone call was made to Mr. Boland on 1-15-2002 to request an oral election to the above restriction requirement, but did not result in an election being made. Applicant has instead requested a written restriction.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention and a species within the elected invention to be examined even though the requirement be traversed (37 CFR 1.143).

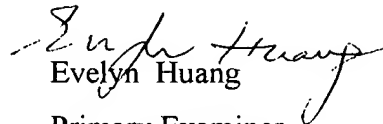
3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evelyn Huang whose telephone number is 703-305-7247. The examiner can normally be reached on Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat can be reached on 703-308-2439. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



Evelyn Huang

Primary Examiner

Art Unit 1625

January 15, 2002



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

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Washington, D.C. 20231

MONTHLY STATEMENT
OF DEPOSIT ACCOUNT

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payable to Commissioner of Patents & Trademarks.

SUGHRUE MION, PLLC

2100 PENNA AVE N W
SUITE 800
WASHINGTON DC 20037



Account No.	194880
Date	4-30-02
Page	8

PLEASE SEND REMITTANCES TO:
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DATE POSTED			CONTROL NO.	DESCRIPTION (Serial, Patent, TM, Order)	DOCKET NO.	FEE CODE	CHARGES/ CREDITS	BALANCE
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AN AMOUNT SUFFICIENT TO COVER ALL SERVICES REQUESTED MUST ALWAYS BE ON DEPOSIT.				OPENING BALANCE	TOTAL CHARGES		TOTAL CREDITS	CLOSING BALANCE